

REMARKS

Claims 1-5, 8-16, 19-27, and 30-38 were pending in this application. No claims have been amended. No claims have been canceled or added. Hence, claims 1-5, 8-16, 19-27, and 30-38 remain pending. For the examiner's convenience, a complete listing of all claims in their current form appears under the heading "PRESENTLY PENDING CLAIMS." Reconsideration of the subject application is respectfully requested.

Claims 1-5, 8-16, 19-27, and 30-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 5,222,120 to McLeod, *et al.* (hereinafter "McLeod") in view of the cited portions of U.S. Patent No. 6,373,817 to Kung *et al.*, (hereinafter "Kung").

With respect to independent claims 1, 16, and 27, which each include the limitation, "wherein the predetermined criteria includes the time, date, or day of week," the office action states, "'The predetermined criteria includes the time, date or day of the week' in the subscriber's profile would obviously reflect how often a service such as the news or the weather would be provided. The subscriber would obviously not want to listen to the weather report every 5 minutes." Applicants disagree. Some subscribers want the same information each time the subscriber goes off-hook. For example, in locations such as Colorado where the weather changes drastically in short periods of time, subscribers need not specify a schedule for receiving information; these subscribers want the same information every time they go off-hook. Thus, it is not obvious that these subscribers would establish predetermined criteria. More importantly, the office action does not cite a reference that teaches this limitation. The only reference for this limitation is the Applicant's claims. Thus, the office action has not established a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the

prior art reference (or references when combined) must teach or suggest all the claim limitations.

(MPEP § 2143) Here, the office action has not met all three criteria. Specifically, the office action has not cited a reference or references that teach or suggest all the claim limitations. Thus, the rejection of these claims is improper.

Further, it would not be desirable to modify McLeod in light of Kung, as suggested by the office action. To do so would force subscribers to initiate all calls, including local phone calls, through a long distance telephone switching system. This would not be desirable. Moreover, the office action does not provide a reference that suggests or motivates modifying McLeod in light of Kung. Applicants note that,

[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

(MPEP § 2143.01) However,

[t]he examiner may take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being well-known in the art. ... If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that official notice can be taken, it is sufficient so to state. ... If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts **must be supported, when called for by the applicant, by an affidavit** from the examiner.

(MPEP § 2144.03, emphasis added) Because no reference is cited that provides a suggestion or motivation to modify McLeod, the Applicants assume the office action is relying on facts within the personal knowledge of the Examiner. The Applicants, therefore, respectfully traverse the rejection and request either an express showing of documentary proof, or an affidavit specifically stating the facts within the personal knowledge of the Examiner, as required by MPEP § 2144.03. (The Applicants have

made this request previously, but have not been provided with either a reference, an express showing of documentary proof, or an affidavit.) Claims 1, 16, and 27 are, therefore, believed to be allowable, at least for these reasons.

Likewise, independent claim 38 is believed to be patentable because the limitation, "including a frequency with which the subscriber selects to receive the information services" is not found in the cited references. As a result, the office action has not established a *prima facie* case of obviousness with respect to claim 38, and it is believed to be allowable, at least for this reason.

Claims 2-5 and 8-15 depend from claim 1, claims 19-26 depend from claim 16, and claims 30-37 depend from claim 27. Thus, the Applicants believe these claims are allowable, at least for the reasons stated above with respect to the independent claims.

Further, the office action does not cite a reference for the teachings of claims 3-5. The office action merely states that, "the use of different types of messages such as text, video, and graphic message would have been obvious to one of ordinary skill in the art at the time the invention was made since the use of multimedia messages is well known and desired." Since the office action does not cite a reference that teaches the limitations of these claims, the office action has not established a *prima facie* case of obviousness, and claims 3-5 are believed to be allowable for this additional reason.

Further still, no reference is cited for the teachings of claims 8, 19, and 30. With respect to these claims, the office action merely states that, "This simply reads on the subscriber's choice of having the service provided during certain times or after making certain number of phone calls. This also may be an agreement between the business and the subscriber in Kung." Applicants note, however, that claims cannot be rejected because a teaching of a reference *may be* the claimed limitation. If the reference does not teach the limitation, then the teaching may not be used to reject the claim. Thus, claims 8, 19, and 30 are believed to be allowable for this additional reason.

Likewise, no reference is cited for the teachings of claims 13, 24, and 35. With respect to these claims, the office action merely states that, "This is obvious because

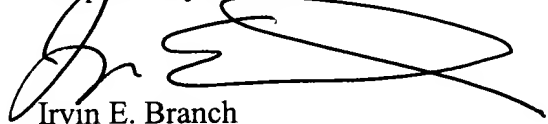
dialing should step the announcement.” Since the office action does not cite a reference that teaches the limitations of these claims, the office action has not established a *prima facie* case of obviousness, and claims 3-5 are believed to be allowable for this additional reason.

The same reasoning applies to claims 11, 22, and 33; no reference is cited for the teachings of these claims. With respect to these claims, the office action states that, “having the communication-network in an advanced intelligent network (AIN) this simply reads on using the features in an advanced intelligent network.” Thus, the office action has not established a *prima facie* case of obviousness with respect to these claims, and they are believed to be allowable, at least for this additional reason.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is urged. If the Examiner believes a telephone conference would aid in the prosecution of this case in any way, please call the undersigned at 303-571-4000.

Respectfully submitted,



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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

1. (Previously Twice Amended) In a communication network comprising a plurality of subscriber telephone lines, each coupled to an associated telephoning switching facility, each subscriber telephone line having at least one directory number and an associated subscriber profile including selected information services, a method for providing information services to a subscriber, comprising:

detecting an off-hook condition at a subscriber telephone line;

determining the information services selected by the subscriber by correlating the subscriber directory number with the selected information services in the subscriber's profile in accordance with predetermined criteria, wherein the predetermined criteria includes the time, date, or day of week; and,

in response to the off-hook condition, generating a message corresponding to the selected information services for receipt by the subscriber.

2. (As Filed) A method as in claim 1, wherein the message is an audio message.

3. (As Filed) A method as in claim 1, wherein the message is a text message.

4. (As Filed) A method as in claim 1, wherein the message is a video message.

5. (As Filed) A method as in claim 1, wherein the message is a graphic message.

6. (CANCELLED)

7. (CANCELLED)

8. (Previously Once Amended) A method as in claim 1, wherein the predetermined criteria includes the time since the last detected "off-hook" condition.

9. (As Filed) A method as in claim 1, wherein while receiving the message, or after the message completes, entering one of a plurality of codes by the subscriber accesses additional information.

10. (As Filed) A method as in claim 9, wherein entering a code by the subscriber accesses the subscriber's correspondence messaging service.

11. (As Filed) A method as in claim 1, wherein the communication network is an advanced intelligent network (AIN).

12. (As Filed) A method as in claim 1, wherein the communication network is a public switched telephone network.

13. (As Filed) A method as in claim 1, wherein selecting an appropriate calling number by the subscriber terminates the message.

14. (As Filed) A method as in claim 13, wherein the subscriber selects an appropriate calling number by generating DTMF (dual tone multi-frequency) tones.

15. (As Filed) A method as in claim 1, wherein the message is terminated when the subscriber goes "on hook" by hanging up the line.

16. (Previously Once Amended) In a wireless communication network comprising a plurality of subscriber telephone lines, each coupled to an associated telephone switching facility, each subscriber telephone line having at least one directory number and an associated subscriber profile including selected information services, a method for providing information services to a subscriber, comprising:

detecting at a switching facility an off-hook condition at a subscriber telephone line;

determining the information services assigned to a subscriber by correlating the subscriber directory number with the selected information services in the subscriber's profile in accordance with predetermined criteria, wherein the predetermined criteria includes the time, date, or day of week; and,

in response to the off-hook condition, generating an audio message corresponding to the assigned information services for receipt by the subscriber in place of dial tone.

17. (CANCELLED)

18. (CANCELLED)

19. (Previously Once Amended) A method as in claim 16, wherein the predetermined criteria includes the time since the last detected "off-hook" condition.

20. (As Filed) A method as in claim 16, wherein while receiving the message, or after the message completes, entering one of a plurality of codes by the subscriber accesses additional information.

21. (As Filed) A method as in claim 20, wherein entering a code by the subscriber accesses the subscriber's correspondence messaging service.

22. (As Filed) A method as in claim 16, wherein the communication network is an advanced intelligent network (AIN).

23. (As Filed) A method as in claim 16, wherein the communication network is a public switched telephone network.

24. (As Filed) A method as in claim 16, wherein selecting an appropriate calling number by the subscriber terminates the message.

25. (As Filed) A method as in claim 24, wherein subscriber selects an appropriate calling number by generating DTMF (dual tone multi-frequency) tones.

26. (As Filed) A method as in claim 16, wherein the message is terminated when the subscriber goes "on hook" by hanging up the line.

27. (Previously Once Amended) In a communication network comprising a plurality of subscriber telephone lines, each coupled to an associated telephoning switching facility, each subscriber telephone line having at least one directory number and an associated subscriber profile including selected information services, a system for providing information services to a subscriber, comprising:

means for detecting an off-hook condition at a subscriber telephone line;

means for determining the information services selected by the subscriber by correlating the subscriber directory number with the selected information services in the subscriber's profile in accordance with predetermined criteria, wherein the predetermined criteria includes the time, date, or day of week; and,

means for generating an audio message, in response to the off-hook condition, corresponding to the selected information services for receipt by the subscriber.

28. (CANCELLED)

29. (CANCELLED)

30. (Previously Once Amended) A method as in claim 27, wherein the predetermined criteria includes the time since the last detected "off-hook" condition.

31. (As Filed) A method as in claim 27, wherein while receiving the message, or after the message completes, entering one of a plurality of codes by the subscriber accesses additional information.

32. (As Filed) A method as in claim 31, wherein entering a code by the subscriber accesses the subscriber's correspondence messaging service.



33. (As Filed) A method as in claim 27, wherein the communication network is an advanced intelligent network (AIN).

34. (As Filed) A method as in claim 27, wherein the communication network is a public switched telephone network.

35. (As Filed) A method as in claim 27, wherein selecting an appropriate calling number by the subscriber terminates the message.

36. (As Filed) A method as in claim 35, wherein the subscriber selects an appropriate calling number by generating DTMF (dual tone multi-frequency) tones.

37. (As Filed) A method as in claim 27, wherein the message is terminated when the subscriber goes "on hook" by hanging up the line.

38. (As Filed) A method of providing information services to a subscriber, comprising:

receiving a selection of information services from a subscriber, including a frequency with which the subscriber selects to receive the information services;

storing the selection of information services and the frequency as a subscriber profile relating to the subscriber;

detecting, via a communications network, an off-hook condition at a subscriber line relating to the subscriber;

consulting the subscriber profile relating to the subscriber to determine the information services selected by the subscriber; and

in response to the off-hook condition, providing the information services to the subscriber via the communications network.